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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/394,521	09/10/1999	NAOYUKI MATSUMOTO	35.G0708C/D2	4346
5514	7590	06/22/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			POKRZYWA, JOSEPH R	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/394,521

Applicant(s)

MATSUMOTO, NAOYUKI

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 3/10/05, and has been entered and made of record. Currently, **claims 25-32** are pending.

Response to Arguments

2. Applicant's arguments, see pages 5-9, filed 3/10/05, with respect to the rejection(s) of claim(s) 25-31, as cited in the previous Office action dated 12/6/04, under 35 U.S.C. 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the reference of Weinberger et al. (U.S. Patent Number 5,084,875).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 25-27, and 32** are rejected under 35 U.S.C. 102(e) as being anticipated by Weinberger et al. (U.S. Patent Number 5,084,875).

Regarding *claim 25*, Weinberger discloses a method of controlling a data communication apparatus (copier 2, seen in Fig. 1) in a data processing system (see Fig. 1) that includes the data communication apparatus (copier 2) and a host computer (mac computer 16) connected to the data communication apparatus by an interface (translator 6), with the method comprising a communication step of communicating commands from the host computer to the data communication apparatus through the interface (column 1, lines 20-68, and column 5, lines 54-64), wherein the data communication apparatus is comprised of units including at least a scanner unit and a printer unit (see Figs. 1-3, whereby scanner and printer units are inherent in copier 2), a checking step of checking, upon receipt of the commands, a status of each of the scanner unit and printer unit of the data communication apparatus (column 5, lines 3-64), wherein the status indicates whether each of the scanner unit and the printer unit is in a normal or abnormal state (see abstract, column 1, line 54-68, column 3, lines 49-56, column 5, lines 54-64, and column 7, line 39-column 8, line 49, whereby the status of the copier, which inherently includes scanner and printer units, are sent to the computer, whereby an error condition would indicate an abnormal state), and indicates a cause of an abnormality in a case where the status of the scanner unit or the printer unit is in an abnormal state (column 8, lines 9-49, wherein the status sent to user of computer 16, "can be used to alert the user to the location and status of an error", thus indicating a cause and a location (scanner unit, printer unit, display unit, etc.) of the abnormality), and a notification step of notifying the host computer of a checked status of each of the scanner unit and the printer unit discretely (see Fig. 10, column 7, line 39-column 8, line 22).

Regarding *claim 26*, Weinberger discloses the method discussed above in claim 25, and further teaches that the notification step notifies the host computer of operating conditions comprising a change in status or internal state of the data communication apparatus (see Fig. 10, column 7, line 51-column 8, line 49).

Regarding *claim 27*, Weinberger discloses the method discussed above in claim 25, and further teaches that the notification step notifies the host computer of the operating conditions in accordance with a command from the host computer (column 5, lines 54-64, and column 7, line 39-column 8, line 22).

Regarding *claim 32*, Weinberger discloses the method discussed above in claim 25, and further teaches that the data communication apparatus further comprises a storage unit for storing a plurality of files (column 3, line 34-column 4, line 49), and the checking step includes checking the status of the storage unit and the notification step includes notifying the host computer of the checked status of the storage unit of the data communication apparatus (column 4, line 31-column 5, line 64).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claim 28** is rejected under 35 U.S.C. 103(a) as being unpatentable over Weinberger *et al.* (U.S. Patent Number 5,084,875) in view of Kita *et al.* (U.S. Patent Number 5,021,892, cited in the Office action dated 12/6/04).

Regarding **claim 28**, Weinberger discloses the method discussed above in claim 25, but fails to expressly disclose if the data communication apparatus is included in a facsimile apparatus.

Kita discloses a method of controlling a data communication apparatus (facsimile 1) in a data processing system (see Figs. 1 and 3) that includes the data communication apparatus (facsimile 1) and a host computer (personal computer 8) connected to the data communication apparatus by an interface (bi-directional parallel interface unit 5, column 3, lines 28-53), with the method comprising a communication step of communicating commands from the host computer to the data communication apparatus through the interface (see Figs. 6, and 8a-8e, being a reception from the host at numeral "2", shown at step S200 in Fig. 9 as the station request command), wherein the data communication apparatus (see Figs. 1 and 3) is comprised of units including at least a scanner unit (image scanner 2) and a printer unit (image printer 3), a checking step of checking, upon receipt of the commands, a status of each of the scanner unit and printer unit of the data communication apparatus (step S201 in Fig. 9, column 13, lines 56-

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66, and column 15, line 51-column 16, line 17), and a notification step of notifying the host computer of a checked status of each of the scanner unit and the printer unit discretely (step S202 in Fig. 9, column 16, lines 1-6). Further, Kita teaches that the data communication apparatus is included in a facsimile apparatus (see Figs. 1 and 3, column 3, lines 28-53).

Weinberger & Kita are combinable because they are from the same field of endeavor, being systems that allow external computers to monitor the status of multifunction devices. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the facsimile function of Kato in the copier system of Weinberger. The suggestion/motivation for doing so would have been that Weinberger's system would become more multi-functional, making the system more desirable to users, as the communication apparatus would perform copy operations, as well as scan, print, and perform facsimile communication, being functions that make a single multi-functional device valuable for users, as recognized by Kita in column 1, lines 10-67. Therefore, it would have been obvious to combine the teachings of Kita with the system of Weinberger to obtain the invention as specified in claim 28.

7. **Claims 29-31** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kita *et al.* (U.S. Patent Number 5,021,892, cited in the Office action dated 12/6/04) in view of Weinberger *et al.* (U.S. Patent Number 5,084,875).

Regarding **claim 29**, Kita discloses a method of controlling a data communication apparatus (facsimile 1) in a data processing system (see Figs. 1 and 3) that includes the data communication apparatus (facsimile 1) and a host computer (personal computer 8), the data

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communication apparatus and the host computer being connected to each other through an interface (bi-directional parallel interface unit 5, column 3, lines 28-53), and the data communication apparatus (facsimile 1) being able to communicate with another device through a network without using the interface (via telephone line 4a, column 3, lines 28-53, and column 6, lines 6-19), the method comprising a command step of communicating commands from the host computer to the data communication apparatus through an interface (see Figs. 6, and 8a-8e, being a reception from the host at numeral "2", shown at step S200 in Fig. 9 as the station request command), wherein the data communication apparatus (see Figs. 1 and 3) is comprised of units including at least a scanner unit (image scanner 2), a printer unit (image printer 3) and a communication unit for communicating with the other device through the network (fax control unit 4), a checking step of checking, upon receipt of the commands, a status of each of the units of the data communication apparatus (step S201 in Fig. 9, column 13, lines 56-66, and column 15, line 51-column 16, line 17), and a notification step of notifying the host computer of a checked status of each of those units discretely (step S202 in Fig. 9, column 16, lines 1-6).

However, Kita fails to expressly disclose if the status indicates whether at least each of the scanner unit and the printer unit is in a normal or abnormal state and indicates a cause of an abnormality in a case where the status of the scanner unit or the printer unit is in an abnormal state.

Weinberger discloses a method of controlling a data communication apparatus (copier 2, seen in Fig. 1) in a data processing system (see Fig. 1) that includes the data communication apparatus (copier 2) and a host computer (mac computer 16), the data communication apparatus and the host computer being connected to each other through an interface (translator 6), with the

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method comprising a command step of communicating commands from the host computer to the data communication apparatus through an interface (column 1, lines 20-68, and column 5, lines 54-64), wherein the data communication apparatus is comprised of units including a scanner unit and a printer unit (see Figs. 1-3, whereby scanner and printer units are inherent in copier 2), a checking step of checking, upon receipt of the commands, a status of each of the scanner unit and printer unit of the data communication apparatus (column 5, lines 3-64), wherein the status indicates whether at least each of the scanner unit and the printer unit is in a normal or abnormal state (see abstract, column 1, line 54-68, column 3, lines 49-56, column 5, lines 54-64, and column 7, line 39-column 8, line 49, whereby the status of the copier, which inherently includes scanner and printer units, are sent to the computer, whereby an error condition would indicate an abnormal state), and indicates a cause of an abnormality in a case where the status of the scanner unit or the printer unit is in an abnormal state (column 8, lines 9-49, wherein the status sent to user of computer 16, "can be used to alert the user to the location and status of an error", thus indicating a cause and a location (scanner unit, printer unit, display unit, etc.) of the abnormality), and a notification step of notifying the host computer of a checked status of each of those units discretely (see Fig. 10, column 7, line 39-column 8, line 22).

Kita & Weinberger are combinable because they are from the same field of endeavor, being systems that allow external computers to monitor the status of multifunction devices. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the status indication of Weinberger in the system of Kita. The suggestion/motivation for doing so would have been that Kita's system would become more user-friendly, as the user would be alerted of the status of an error and a location, so as to conduct the appropriate action,

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as recognized by Weinberger in column 8, lines 9-49. Therefore, it would have been obvious to combine the teachings of Weinberger with the system of Kita to obtain the invention as specified in claim 29.

Regarding *claim 30*, Kita and Weinberger disclose the method discussed above in claim 29, and Kita further teaches that the notification step notifies the host computer of a model type and a model version in one set (see Figs. 4 and 5, and column 8, lines 5-48).

Regarding *claim 31*, Kita and Weinberger disclose the method discussed above in claim 29, and Kita further teaches that the data processing apparatus is included in a facsimile apparatus (see Figs. 1 and 3, column 3, lines 28-53).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

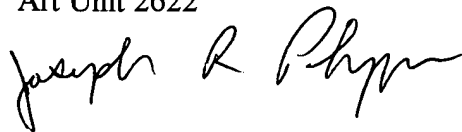
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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Primary Examiner
Art Unit 2622



jrp